G

Y. Frank Jou
January 27, 2006

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE
C.A:04-1199 (SLR)

SRI INTERNATIONAL, INC.,   )
a California Corporation   )
)
    Plaintiff and   )
    Counterclaim Defendant,   )
)
        v.   )
)
INTERNET SECURITY SYSTEMS, INC.,)
a Delaware Corporation, INTERNET)
SECURITY SYSTEMS, INC., a Georgia)
Corporation, and SYMANTEC   )
CORPORATION, a Delaware   )
Corporation,   )
)
    Defendants and   )
    Counterclaim-Plaintiffs.   )
_ _ _ _ _ _ _ _ _ _ _)

VIDEOTAPED DEPOSITION

OF

Y. FRANK JOU

At Raleigh, North Carolina   Reported by:
January 27, 2006 - 9:53 a.m.   Debra D. Bowden

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1   yeah, it -- sorry, I couldn't --

2   Q.   Maybe when we take a break I'll call to my

3   office and see if we have that in house.

4   A.   Yeah, that would tell us clearly, you know.

5   Because we had reference date here, and if

6   the BAA is before this, then certainly, you

7   know, this is -- but I would think this

8   must be the discussion notes I took, you

9   know, between MCNC and NC State at the time

10   to come up with the proposal. So

11   definitely this would be after, I would say

12   this is after the BAA is announced. But

13   whether, you know, before we submit a

14   proposal or not, I think that was the

15   question I had. You know, whether this was

16   before we submit a proposal or afterwards.

17   Definitely, you know, the context of these

18   notes was the discussion related to JiNao,

19   and certainly that took place after we saw

20   the BAA, as I recall.

21   Q.   With respect to the stats based part of

22   JiNao --

23   A.   Um-hmm.

24   Q.   -- did you use an algorithm that was

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1   developed at SRI?

2   A.   Yes, pretty much that was the phase

3   algorithm. We might have modified certain

4   parameters there, but the framework was

5   borrowed from SRI, as I recall, called

6   NIDES, N-I-D-E-S.

7   Q.   And how did it come to be that you used the

8   SRI NIDES algorithm?

9   A.   Well, at that time, as I recall, DARPA

10   actually promote the idea. You know, other

11   people's -- you know -- the research

12   results, you know. There is nothing

13   preventing -- because we are not for

14   commercial purpose. So actually that was

15   encouraged by DARPA so that you can, you

16   know, help others and come up with

17   something more advanced. That was I think

18   one of the reasons, you know, the project

19   was selected, because we view it on top of

20   them and come up with integrated solution.

21   Q.   To your knowledge, was the NIDES algorithm

22   used for network data, internet network

23   data?

24   MS. PRESCOTT: Objection to form.

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 1         we were interested in protecting at that

 2         time, and OSPF finally was the target

 3         protocol that we chose to focus our effort

 4         upon.

 5    Q.   Did the NIDES algorithm -- well, let's step

 6         back.  Did you receive a NIDES algorithm

 7         from SRI?

 8    A.   Did I receive?  No.  I basically searched

 9         the internet and -- basically we came up

10         with this true complementary algorithm, if

11         you will, one is statistical based, one is

12         protocol analysis based.  So you know, we

13         look around how we implement this.  And so

14         we search around, and we understand NIDES

15         already developed a certain very nice

16         algorithm in the statistical analysis

17         arena.  So that's why we talked to SRI

18         folks and, you know, get a -- a detail of

19         their algorithm.  And we use that as a

20         base.  Yeah.

21    Q.   When did you start contact with SRI?

22    A.   When did I start contact with SRI?  I don't

23         recall exactly, but somewhere around that

24         time frame, I would say.  After we
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1   establish statistical algorithm as the

2   component, one of the major component in

3   our design, we did a prior search, if you

4   will, and then we found out SRI has this

5   algorithm available. Developed, I should

6   say. And so we talked to them. As far as

7   time frame, I don't recall, you know,

8   exactly when that happened.

9   Q. Do you recall who you spoke with first at

10   SRI about the statistical algorithm?

11   A. Did I recall who I spoke to first? I don't

12   recall clear, exactly, but one of three

13   persons, I would say, was Peter Neumann was

14   one possibility, and Al was another one,

15   and Phil Porras was another one. Yeah, I

16   think one of three. I don't recall who I

17   spoke to first, but yeah.

18   Q. And Al, you mean Al Valdes.

19   A. Yes.

20   Q. If you could page into the notes into the

21   laboratory images 68 and 69. And you'll

22   see the entry at 68 is 82796.

23   A. Um-hmm.

24   Q. And the top is Teresa Lunt. Do you see

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1   Q.   Did you meet with Mr. Valdes about that

2   time frame?

3   A.   Yeah, based upon these, I think yeah, I did

4   meet with him.

5   Q.   Do you recall if you met with anybody else

6   at SRI?

7   A.   Do you mean during the conference, or

8   afterwards, or --

9   Q.   Afterwards.

10 A.   Afterwards, if I recall correctly, I might

11   have paid them a visit at SRI. And you

12   know, to -- I visited them once. That's

13   what I recall. But I don't know whether

14   this was the time I visit them. But this

15   might be that time. Yeah.

16 Q.   Now, at your visit do you remember -- well,

17   do you remember who you met with at SRI

18   during that visit?

19 A.   The main one I thought was Al. Because

20   that was -- you know, Phil might be there

21   as well, but I don't -- I couldn't be

22   hundred percent sure, but if I visit them

23   at that time, I think it's mainly to

24   understand better what other statistical

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1   methodology they developed, so basically

2   went there to get a better understanding of

3   the NIDES, the statistical module. Yeah.

4   Q.   Do you remember what Mr. Valdes told you

5   about the statistical methodology?

6   A.   Well, basically they -- if I recall

7   correctly, I got a technical report from

8   them about this NIDES statistical

9   algorithm. You know, so -- and basically

10   he went over briefly with me, you know, how

11   it came about, what's the gist of the

12   algorithm. Yeah.

13   Q.   Were there any discussions at this meeting

14   about using network data as a data source

15   for the statistical algorithm?

16   A.   Network data? Are you referring to OSPF?

17   Q.   Yes.

18   A.   I thought, you know, we made it clear, our

19   target, the target of our protection was

20   neuro infrastructures, basically the OSPF.

21   So I don't recall whether we made it clear

22   again during that visit or during that

23   conversation, but certainly that, you know,

24   in our presentation we -- we made it clear

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 1              actually was held in the -- in Rome Lab,

 2              Massachusetts.  And I don't recall when.

 3              Unless you have other e-mail to show, I

 4              don't recall when was that, you know,

 5              meeting took place.

 6      Q.      The e-mail back from Phil Porras to you was

 7              November 4th, 1996.

 8      A.      Um-hmm.

 9      Q.      Does that help you recollect whether the

10              kick-off meeting was in the fall of 1996?

11      A.      Yeah, should be that time frame.  Yeah,

12              should be that time frame.

13      Q.      Now, you state in the second sentence, "In

14              preparing this meeting we need to provide

15              our contracting officer an estimate as to

16              when our statistical module can be

17              delivered."

18      A.      Um-hmm.

19      Q.      "Since our implementation will be based on

20              yours --"

21      A.      Um-hmm.

22      Q.      "-- would you please give me a time frame

23              when your revision will be ready?"

24      A.      Um-hmm.
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1   Q.   Do you recollect what revision you were

2   seeking from SRI?

3   A.   At that time, based on these e-mail notes,

4   probably they are under -- they underwent a

5   revision of their algorithm. This is the

6   best explanation I can come up with. And

7   so they're perhaps fine tuning, perhaps,

8   you know, some revision going on at that

9   time. And they indicated that, you know,

10   they will be able to provide with a revised

11   version to us. So that was the question I

12   posed on them, basically asking a feel, you

13   know, because our project will be using

14   theirs as a foundation of the base module.

15   So I basically tried to interlock with

16   them. You know, make sure our project will

17   be able to deliver based upon their revised

18   algorithm.

19 Q.   Does this refresh your recollection as

20   to -- well, let me rephrase that.

21   What did you mean by statistical

22   module? Is that software?

23 A.   That was a design in our architecture. One

24   component is called statistical module.

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1   All of the -- that's -- yeah, that's an

2   architectural design. Interpretation, it

3   was a software; correct.

4   Q.   Did SRI give you software?

5   A.   No. They have the algorithm developed, you

6   know, and it was presented in the technical

7   report form. And basically we used that

8   algorithm as a base to implement, so the

9   software was written by ourselves.

10   Q.   Is this what you would call an

11   architectural design document?

12   MS. PRESCOTT: Objection to form.

13   A.   Which one?

14   Q.   I'm trying to understand what they gave

15   you.

16   A.   They gave me the algorithm. Um-hmm.

17   Q.   From the algorithm, could you then

18   implement their statistical technique?

19   A.   Yes.

20   Q.   Ask the court reporter to mark at J8

21   document bearing production numbers ISS

22   00354559 to ISS 354606.

23   (Exhibit J8 was marked.)

24   This document is entitled Proceedings

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1   meant -- what I meant was the capability we

2   implement was local in nature.

3 Q. Um-hmm.

4 A. And as the goal we try to achieve was to be

5   able to scale this capability to a global

6   label. So that was my intent in this

7   description here. Basically as a next step

8   in the capability it should be extend from

9   local to a global area. Global scope.

10   Yeah.

11 Q. Okay. And now the DARPA project was a

12   three-year project; correct?

13 A. Right.

14 Q. It was a limited in time; correct?

15 A. Yeah, um-hmm.

16 Q. And limited in funding money; correct?

17 A. Yeah.

18 Q. Had you had more time and money, would you

19   have taken that natural extension step to a

20   more global system?

21 A. Definitely that was in our intent. But you

22   know, again I should say this was a

23   research project. There was no guarantee,

24   you know, we would be able to bear any

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 1   fruit even though if the time or resource

 2   is allowed at that point in time.

 3   Q.   If you go back to the architecture

 4   document, J18, on page 3.

 5   A.   Page 3. Okay.

 6   Q.   And if you go to Section 2.1.

 7   A.   Um-hmm.

 8   Q.   And you go to the third paragraph.

 9   A.   Um-hmm.

10   Q.   The middle of it. And you say, "While it

11   is not within the scope of this project, we

12   expect that the detection analysis

13   functions implemented in the local

14   subsystem can be extended to a global level

15   and correlate intrusion events among

16   several routers." Do you see that?

17   A.   Um-hmm.

18   Q.   And then it goes on to say, "The management

19   capability which is based on SNMP framework

20   can logically be further extended among

21   management notes in a hierarchical fashion

22   to establish a status map for an autonomous

23   system."

24   A.   Um-hmm.

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1   Q.   Now, while your DARPA project was limited

2   in time and funding, did you create the

3   design such that it could be extended in

4   this hierarchical fashion?

5   A.   I would not say created, because the SNMP

6   network by its nature is to monitor remote

7   system.

8   Q.   Um-hmm.

9   A.   And be able to reflect a healthy -- the

10   healthy -- the status of the network, you

11   know, it's healthy, whether it's healthy or

12   it's, you know, under stress. That was the

13   intent of the SNMP framework. And our

14   thinking at that point in time was to take

15   advantage of this SNMP by the fact that

16   it's able to monitor several systems in a

17   distributive fashion. And you know, the

18   challenge at that point was how do you

19   correlate. I think that was the main

20   technical challenge at that point in time

21   in terms of how do you collect -- collect

22   of the local detection result was not an

23   issue. The issue was how do you come up

24   with the intelligence, how do you correlate

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 1          all the relevant information and be able

 2          to, you know, derive a certain logical or

 3          reasonable conclusion, and able to, based

 4          upon this result, take action accordingly.

 5          I think that was the challenge, and the --

 6          you know, we did look into that aspect.

 7          But however at that point we did not have a

 8          very promising, you know, development at

 9          that time.  At the conclusion of the

10          project.  So that was, you know, the open

11          question at that point.

12    Q.    And if you just saw the term correlate --

13    A.    Um-hmm.

14    Q.    -- what would that mean to you?

15              MS. PRESCOTT:  Objection to form.

16    A.    Correlate means how do you put two or more

17          than two input together and derive

18          meaningful information, or intelligence,

19          out of these different infrastreams of

20          information, and be able to come up with

21          certain rationale or logic that what this,

22          you know, behavior manifests to itself.

23              Probably that's kind of lengthy or

24          wordy, but that's my understanding of this
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UNITED STATES DISTRICT Court

DISTRICT OF DELAWARE

SRI INTERNATIONAL, INC.,
a California corporation

    Plaintiff and
    Counterclaim-Defendant,
vs.   No. 04-1199 (SLR)

INTERNET SECURITY SYSTEMS, INC.,
a Delaware corporation; INTERNET
SECURITY SYSTEMS, INC., a Georgia
corporation; and SYMANTEC
CORPORATION, a Delaware corporation,

    Defendants and
    Counterclaim-Plaintiffs.   /

DEPOSITION OF GEORGE KESIDIS

VOLUME I

DATE: May 25, 2006

TIME: 9:13 a.m.

LOCATION: DAY CASEBEER MADRID & BATCHELDER
                   20300 Stevens Creek Boulevard
                   Suite 400
                   Cupertino, CA 95014

REPORTED BY: KAREN L. BUCHANAN
                     CSR No. 10772

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10:29:18	1	THE WITNESS: I'm not quite sure what you
10:29:18	2	mean, "the same."
10:29:19	3	BY MS. MOEHLMAN:
10:29:22	4	Q. Do they both stem from the NIDES algorithm?
10:29:23	5	A. Does EMERALD stem from NIDES?
10:29:28	6	Q. I'm talking about the statistical anomaly
10:29:31	7	algorithms described in the patents in suit, and I'm
10:29:35	8	talking about the statistical anomaly algorithms
10:29:37	9	discussed in the JiNao paper.
10:29:38	10	MR. POLLACK: Objection. Vague and
10:29:42	11	ambiguous, lacks foundation.
10:29:46	12	THE WITNESS: Again, a lot of the jargon is
10:29:50	13	the same. They're both statistical approaches. But
10:29:50	14	the context is very different, so I would say no.
10:29:53	15	BY MS. MOEHLMAN:
10:29:56	16	Q. How is the context very different, in your
10:29:56	17	opinion?
10:29:59	18	A. The context is -- that statement I made is
10:30:02	19	simply pointing out that you're looking in the one
10:30:09	20	case at host-based audit logs and in the other case at
10:30:13	21	network packets whizzing by on the wire. So any
10:30:18	22	statistical algorithms, statistical algorithms, will
10:30:23	23	have gross features in common but, depending on the
10:30:25	24	time series and the nature of the data you're
	25	examining, will necessarily be quite different.

BELL & MYERS, CERTIFIED SHORTHAND REPORTER, INC. (408) 287-7500

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10:30:33	1	Q. And it is your opinion that JiNao did not
10:30:35	2	look at network packets?
10:30:39	3	A. Not in the same fashion that the EMERALD
10:30:42	4	network service monitors do.
10:30:46	5	Q. Did the JiNao system look at network
10:30:46	6	packets?
10:30:48	7	MR. POLLACK: Objection. Vague and
10:30:50	8	ambiguous, asked and answered.
10:30:53	9	THE WITNESS: Did it look at network packets?
10:31:03	10	It clearly reacted to network packets, so it
10:31:03	11	definitely -- it definitely reacted to them.
10:31:06	12	BY MS. MOEHLMAN:
10:31:10	13	Q. What do you mean, it reacted to network
10:31:10	14	packets?
10:31:19	15	A. Well, JiNao is primarily about detection of
10:31:25	16	anomalies that pertain to the routing protocol, in
10:31:32	17	this case, OSPF, the interior gateway protocol of
10:31:33	18	OSPF. And this protocol -- a protocol is a program
10:31:39	19	that's run by different machines, and they message
10:31:43	20	each other as part of the execution of the program.
10:31:46	21	And in the Internet, those messages are carried in
10:31:47	22	Internet packets.
10:31:52	23	So in that sense, the messaging of the
10:32:00	24	protocol uses IP, and JiNao is about examining the
	25	operation of OSPF in a router. And that operation

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10:32:13	1	reacts to route updates and other kinds of
10:32:16	2	OSPF-related messages that are delivered by packets.
10:32:20	3	So I can't say that it doesn't react to packets,
10:32:26	4	therefore.
10:32:31	5	Q. So is it your opinion that algorithms that
10:32:39	6	look at information about routing would not be
10:32:40	7	relevant to the patents in suit?
10:32:43	8	MR. POLLACK: Objection. Lacks foundation,
10:32:47	9	vague and ambiguous.
10:32:52	10	THE WITNESS: I would say no. I would say
10:32:56	11	that it depends on how you look at those packets. And
10:32:59	12	that's the key difference between a host-based and a
10:33:05	13	network-based sensor. It's really a matter of the --
10:33:11	14	how you react to them and the kinds of -- the kinds of
10:33:14	15	operations you do as a result of observing such a
10:33:19	16	packet and how you observe the packet: Are you simply
10:33:24	17	taking note of the fact that it's a packet, or are you
10:33:27	18	probing deeper into the payload, and everything in
10:33:34	19	between. It's really fundamentally a question
10:33:38	20	about -- I think I said, how you're reacting to the
10:33:42	21	packet and what attributes of the packet you're
10:33:42	22	reacting to.
10:33:56	23	BY MS. MOEHLMAN:
10:33:59	24	Q. What attribute -- if you were looking at a
	25	routing protocol, what attributes of a routing

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10:40:10	1	MS. MOEHLMAN: I'm just trying to understand
10:40:14	2	your testimony, because you just spent several pages
10:40:18	3	talking about how the network packets examined by
10:40:22	4	JiNao don't fall within this claim. And you pointed
10:40:25	5	to network surveillance. So when I asked you about
10:40:28	6	network surveillance, you testified that you look at
10:40:31	7	all packets on the wire. So when you say all packets
10:40:35	8	on the wire, what particularly do you need to look at
10:40:37	9	within a packet, or could it be anything?
10:40:39	10	MR. POLLACK: Objection. Mischaracterizes
10:40:43	11	the testimony. Vague and ambiguous. Lacks
10:40:49	12	foundation.
10:40:51	13	THE WITNESS: So the point is that when I
10:40:54	14	have -- when I'm doing network surveillance, I'm
10:40:57	15	looking at the packets as they're flowing by on the
10:41:04	16	wire or through some reconnaissance port of the
10:41:10	17	router. And all I have to -- in the sense of just
10:41:14	18	trying to deal with this torrent of information, I'm
10:41:18	19	typically, in the cont,ext of these patents examining
10:41:27	20	fields in the header of the packet. And only in a
10:41:31	21	very, very rudimentary way could I be exploring
10:41:31	22	elements of the payload.
10:41:36	23	BY MS. MOEHLMAN:
10:41:39	24	Q. And how did JiNao not look at packets
	25	flowing on the wire?

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10:41:51	1	A. Well, in a couple of ways. The first is that
10:41:58	2	it's examining only those packets that are in receipt
10:42:04	3	by the router that it's trying to protect and on which
10:42:12	4	it's trying to conduct intrusion detection. And only
10:42:15	5	those packets that, in the case of the example in the
10:42:29	6	paper, are germane to OSPF. And it's certainly
10:42:31	7	reacting to elements in the payload to a level of
10:42:34	8	detail that's simply out of the scope of these patents
10:42:43	9	and would simply not be feasible. I went through the
10:42:47	10	noninfringement story with regards -- sorry, the
10:42:51	11	validity story with regard to JiNao in my report, and
10:42:53	12	I could look through it.
10:42:55	13	Q. Feel free to reference it if you need to.
10:42:59	14	But I'm trying to ask you questions, and if you need
10:43:03	15	to reference it, that's why I marked all of these
10:43:10	16	exhibits, so feel free. Let me ask you, just going
10:43:15	17	to the next element on the '338 patent where it says,
10:43:18	18	"receiving network packets handled by a network
10:43:25	19	entity." I believe you said a router is a network
10:43:25	20	entity. Am I right?
10:43:27	21	A. Sure.
10:43:32	22	Q. And did JiNao receive packets handled by a
10:43:39	23	router?
10:43:39	24	MR. POLLACK: Objection. Vague and
	25	ambiguous.

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10:43:44	1	THE WITNESS: In that context, sure. It
10:43:47	2	reacted to packets that are -- certain packets that
10:43:56	3	are received by the router. So in the sense that it
10:43:56	4	reacts to those packets, it receives them.
10:44:11	5	BY MS. MOEHLMAN:
10:44:17	6	Q. And as part of the OSPF protocol, is there
10:44:19	7	something called a HELLO packet?
10:44:20	8	A. Sure.
10:44:23	9	Q. And what does a HELLO packet do?
10:44:32	10	A. It simply identifies the OSPF speaker to its
10:44:41	11	peers.
10:44:45	12	Q. And does that indicate a network connection?
10:44:46	13	MR. POLLACK: Objection. Vague and
10:44:46	14	ambiguous.
10:44:54	15	THE WITNESS: Network connection? In a very
10:45:06	16	general sense, yes. Essentially, if I'm in receipt of
10:45:10	17	a HELLO packet from an OSPF speaker, I know that that
10:45:10	18	speaker is therefore connected to the network.
10:45:12	19	BY MS. MOEHLMAN:
10:45:19	20	Q. Did JiNao build long-term profiles,
10:45:21	21	long-term statistical profiles?
10:45:25	22	MR. POLLACK: Objection. Vague and
10:45:26	23	ambiguous.
10:45:29	24	THE WITNESS: Well, I guess in my reading of
	25	JiNao, I can't really say that it -- you know, in my

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10:49:22	1	A. Because it's not -- it's fundamentally not a
10:49:24	2	method of network surveillance.
10:49:27	3	Q. So it's your opinion that it does not meet
10:49:29	4	the preamble?
10:49:38	5	A. That's correct, yeah.
10:49:42	6	Q. Does it meet the first element, receiving
10:49:47	7	network packets handled by a network entity?
10:49:48	8	MR. POLLACK: Objection. Vague and
10:49:48	9	ambiguous.
10:49:51	10	THE WITNESS: The router receives the
10:49:55	11	packets, strictly speaking. So JiNao is a mechanism
10:49:57	12	sitting in a router that reacts to the receipt of
10:50:01	13	those packets. So I would say qualifying it, yeah,
10:50:01	14	you're right.
10:50:06	15	BY MS. MOEHLMAN:
10:50:11	16	Q. So does JiNao meet that first element or
10:50:12	17	not?
10:50:16	18	A. I -- I mean, again, it's not receiving the
10:50:20	19	network packet. It's reacting to certain attributes
10:50:24	20	of it that are -- the packets already in receipt by
10:50:28	21	the router or the line card on which JiNao is
10:50:29	22	functioning.
10:50:34	23	Q. So if I had a component that receives data
10:50:40	24	from a router, would that meet the claim? Could that
	25	possibly meet that claim element?

I

(A) Consider the information properly submitted in an IDS in the same manner that the examiner considers other documents in Office search files while conducting a search of the prior art in a proper field of search.

(1) For e-IDS, use the e-IDS icon on examiner's workstation to consider cited U.S. patents and U.S. patent application publications. See MPEP § 609.07 for more information on e-IDS.

(2) Initial the blank column next to the citation to indicate that the information has been considered by the examiner.

(B) Draw a line through the citation to show that it has not been considered if the citation fails to comply with all the requirements of 37 CFR 1.97 and 37 CFR 1.98. - The examiner should inform applicant the reasons why a citation was not considered.

(C) Write "not considered" on an information disclosure statement if none of the information listed complies with the requirements of 37 CFR 1.97 and 37 CFR 1.98. - The examiner will inform applicant the reasons why the IDS was not considered by using form paragraphs 6.49 through 6.49.09.

(D) Sign and date the bottom of the IDS listing.

(E) Ensure that a copy of the IDS listing that is signed and dated by the examiner is entered into the file and mailed to applicant.<

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609.02   Information Disclosure Statements in Continued Examinations or Continuing Applications [R-3]

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*IDS IN CONTINUED EXAMINATIONS OR CONTINUING APPLICATIONS

A. IDS That Has Been Considered (1) in the Parent Application, or (2) Prior to the Filing of a Request for Continued Examination (RCE)

1.   Continued Prosecution Applications (CPAs) Filed Under 37 CFR 1.53(d) **

Information which has been considered by the Office in the parent application of a continued prose-

cution application (CPA) filed under 37 CFR 1.53(d) ** will be part of the file before the examiner and need not be resubmitted in the continuing application to have the information considered and listed on the patent.

2.   Continuation Applications *>,< Divisional Applications, ** or Continuation-In-Part Applications Filed Under 37 CFR 1.53(b)

The examiner will consider information which has been considered by the Office in a parent application when examining (A) a continuation application filed under 37 CFR 1.53(b) ** (B) a divisional application filed under 37 CFR 1.53(b) ** or (C) a continuation-in-part application filed under 37 CFR 1.53(b). A listing of the information need not be resubmitted in the continuing application unless the applicant desires the information to be printed on the patent.

>

If resubmitting a listing of the information, applicant should submit a new listing that complies with the format requirements in 37 CFR 1.98(a)(1). Applicants are strongly discouraged from submitting a list that includes copies of PTO/SB/08 (PTO-1449) or PTO-892 forms from other applications. A completed PTO/SB/08 or PTO-1449 form from another application may already have initials of an examiner and the application number of another application. This information will likely confuse the record. Furthermore, when the spaces provided on the form have initials of an examiner, there are no spaces available next to the documents listed for the examiner of the subsequent application to provide his or her initials, and the previously relevant initials may be erroneously construed as being applied for the current application.<

3.   Requests for Continued Examination (RCE) Under 37 CFR 1.114

Information which has been considered by the Office in the application before the filing of a RCE will be part of the file before the examiner and need not be resubmitted to have the information considered by the examiner and listed on the patent.